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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
STOCKTON, LAURA LYNNE	

ART UNIT	PAPER NUMBER
1626	

DATE MAILED: 02/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/758,253	YAMAMOTO ET AL.	
	Examiner	Art Unit	
	Laura L. Stockton, Ph.D.	1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 January 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) *10,11,16 and 17* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8, 12-15 and 18-20* is/are rejected.

7)☒ Claim(s) *9* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *4/16/04,7/28/04&.*9/6/05
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

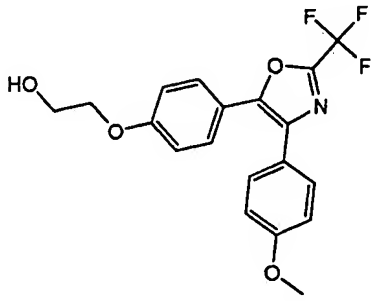
Claims 1-20 are pending in the application.

Election/Restrictions

Applicants' election with traverse of Group I, and the species of Example 41 found on page 58 of the specification (reproduced below), in the reply filed on January 9, 2006 is acknowledged.

Example 41

2-{4-[4-(4-Methoxyphenyl)-2-(trifluoromethyl)-1,3-oxazol-5-yl]phenoxy}ethanol



The traversal is on the ground(s) that a search of all the claims would not present an undue burden. In response, separate search considerations are involved for each of the groups outlined in the Restriction

requirement as noted by the different classifications. Therefore, it would impose an undue burden on the Examiner and the Patent Office's resources if the instant application were unrestricted.

Additionally, the elected invention of Group I is not allowable. See below rejections. In accordance with M.P.E.P. §821.04 and *In re Ochiai*, 71 F.3d 1565, 37 USPQ 1127 (Fed. Cir. 1995), rejoinder of product claims with process claims commensurate in scope with the allowed product claims will occur following a finding that the product claims are allowable. Until, such time, a restriction between product claims and process claims is deemed proper. Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution to maintain either dependency on the product claims or to otherwise include the limitations of the product

claims. **Failure to do so may result in a loss of the right to rejoinder.**

The requirement is still deemed proper and is therefore made FINAL.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

The Examiner has considered the Information Disclosure Statements filed on April 16, 2004, July 28, 2004 and July 6, 2005.

Claim Objections

Claims 12-14 and 18 are objected to for being substantial duplicates of the claims from which they depend. Since no other ingredient is stated in claims 14, 18 and 19, these claims have been interpreted as compound claims. When two claims in an application are duplicates, or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to reject the other as being a substantial duplicate of the allowed claim. M.P.E.P. §706.03(k).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 13 and 18-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In *In re Wands*, 8 USPQ2d 1400 (1988), factors to be considered in determining whether a disclosure meets the enablement requirement of 35 U.S.C. § 112, first paragraph, have been described. They are:

1. the nature of the invention,
2. the state of the prior art,
3. the predictability or lack thereof in the art,
4. the amount of direction or guidance present,
5. the presence or absence of working examples,
6. the breadth of the claims,
7. the quantity of experimentation needed, and
8. the level of the skill in the art.

The nature of the invention

Applicants are claiming products that prevent or treat diseases such as autoimmune diseases, cancer, etc. by administering a compound of formula (I). See, for example, instant claim 13. From the reading of the specification, it appears that Applicants are asserting that the embraced compounds, because of their mode action which involves the antagonizing or agonizing cyclooxygenase, would be useful for treating or preventing numerous diseases and disorders. See pages 215-216 of the instant specification.

The state of the prior art and the predictability or lack thereof in the art

The state of the prior art is that cancer therapy, for example, remains highly unpredictable. The various types of cancers have different causative agents, involve different cellular mechanisms, and consequently, differ in treatment protocol. It is known (see Golub et al., Science, Vol. 286, October 15,

1999, pages 531-537) that the challenge of cancer treatment has been to target specific therapies to pathogenetically distinct tumor types, to maximize efficacy and minimize toxicity. Cancer classification has been based primarily on morphological appearance of the tumor and that tumors with similar histopathological appearance can follow significantly different clinical courses and show different responses to therapy (Golub et al., Science, Vol. 286, October 15, 1999, pages 531-537). There is no absolute predictability even in view of the seemingly high level of skill in the art. The existence of these obstacles establishes that the contemporary knowledge in the art would prevent one of ordinary skill in the art from accepting any therapeutic regimen on its face. Additionally, for example, inflammation is a process that can take place in virtually any part of the body. There is a vast range of forms that it can take, causes for the problem, and biochemical pathways.

The amount of direction or guidance present and the presence or absence of working examples

There is no evidence of record, which would enable the skilled artisan in the identification of the people who have the potential of becoming afflicted with the numerous diseases or disorders claimed herein. That a single class of compounds can be used to treat or prevent all diseases embraced by the claims is an incredible finding for which Applicants have not provided supporting evidence. Applicants have not provided any competent evidence or disclosed tests that are highly predictive for the pharmaceutical use for treating or preventing any or all conditions by administering the instant claimed compounds.

The breadth of the claims

The breadth of the claims are products that can be used to treat or prevent of all diseases and disorders generically embraced in the claim language.

The quantity of experimentation needed

The nature of the pharmaceutical arts is that it involves screening *in vitro* and *in vivo* to determine which compounds exhibit the desired pharmacological activities for each of the diseases and disorders instantly claimed. The quantity of experimentation needed would be undue when faced with the lack of direction and guidance present in the instant specification in regards to testing all diseases and disorders generically embraced in the claim language, and when faced with the unpredictability of the pharmaceutical art. Thus, factors such as "sufficient working examples", "the level of skill in the art" and predictability, etc. have been demonstrated to be sufficiently lacking in the instant case for the instant method claims.

The level of the skill in the art

Even though the level of skill in the pharmaceutical art is very high, based on the

unpredictable nature of the invention and state of the prior art and lack of guidance and direction, one skilled in the art could not use the claimed invention without undue experimentation.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8, 12-15 and 18-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, under the definition of the R^1 variable, the expression "described later on (lower)alkyl" is unclear as to its meaning (page 217, lines 15-16). In claim 1, under the R^5 definition, the expression "described later on carbamoyl" (page 218,

lines 9-10) and the expression "described later on aryl" (page 218, lines 11-12) are also unclear as to their meaning. See claim 2 for same.

Claims 13, 18 and 20 are indefinite because of the expression "and/or" since it is not possible to treat and prevent at the same time.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8, 12-15 and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by:

a) CA Registry No. 412309-17-2 - entry date into the Registry file on STN is May 8, 2002;

b) Norman et al. {U.S. Pat. 5,719,163} - see, for example, column 6, lines 5-6, the compound in column 60, lines 50-51, etc.;

c) Talley et al. {WO 96/36617} - see, for example, the compound on page 21, lines 27-28, the compound on page 22, lines 31-32, etc.;

d) Barreau et al. {EP 517,591} - see, for example, the compound on page 11, line 8, etc.;

e) Barreau et al. {U.S. Pat. 5,403,852} - see, for example, the compound in column 6, lines 61-62; the compound in column 6, lines 67-68, etc.;

f) van Es et al. {CA 58:10186a-c, 1963} - see, for example, the compound of CA Registry No. 92856-11-6, etc.;

g) Dahm et al. {U.S. Pat. 4,051,250} - see, for instance, Example 32 in column 57, lines 28-30, the compound in column 57, line 35, etc.;

h) Fitzi et al. {U.S. Pat. 3,901,908} - see, for example, the compound in column 19, line 9, the compound in column 19, line 35, etc.;

i) Klose et al. {CA 100:22620, 1984} - see, for example, the compound of CA Registry No. 84589-36-6, the compound of CA Registry No. 14003-68-0, etc.;

j) Fitzi et al. {CA 82:43425, 1975} - see, for example, the compound of CA Registry No. 54551-64-3, etc.;

k) Strzybny et al. {CA 72:43563, 1970} - see, for example, the compound of CA Registry No. 25220-22-8, the compound of CA Registry No. 25220-26-2, etc.;

l) Siegrist et al. {CA 80:146981, 1974} - see the compound of CA Registry No. 16112-17-7;

m) Derible et al. {FR 2,156,486} - see, for example, Compound 1285-04, Compound 1285-08, etc. in Table 1 on page 4;

n) Brown {U.S. Pat. 3,578,671} - see, for instance, Example 2 in column 3, Example 3 in column 4, etc.;

o) Hakimelahi et al. {CA 86:189783, 1977} - see, for example, the compound of CA Registry No. 49656-08-8, the compound of CA Registry No. 62762-74-7, etc.;

p) Brown {GB 1,206,403} - see, for instance, Example 2 on page 4, Example 9 on page 5, etc.;

q) Bal'on et al. {CA 115:71469, 1991} - see, for example, the compound of CA Registry No. 135120-40-0, etc.

r) Cahill et al. {CA 121:144101, 1994} - see the compound of CA Registry No. 157189—22-5;

s) Ulbricht {CA 108:160931, 1988} - see, for example, the compound of CA Registry No. 113853-19-3;

t) Jordan et al. {CA 124:327958, 1996} - see, for example, the compound of CA Registry No. 176678-52-7;

u) Lemmens et al. {CA 101:6947, 1984} - see, for example, the compound of CA Registry No. 62762-78-1, etc.;

v) Willems et al. {CA 57:12457f-I, 12458a, 1962} - see, for example, the compound of CA Registry No. 6670-17-3, etc.;

w) Gompper {CA 51:5754g-I, 5755a-I, 5756a-c, 1957} - see the compound of CA Registry NO. 101274-25-3;

x) Berggren et al. {CA 127:338911, 1997} - see the compound of CA Registry No. 178761-59-6;

y) Sallmann {CA 97:92274, 1982} - see the compound of CA Registry No. 82258-07-9;

z) Sharanin {CA 94:192195, 1981} - see the compound of CA Registry No. 77151-48-5;

aa) Harrison et al. {GB 1,552,126} - see Example 15 on page 5;

ab) Maeda et al. {CA 86:189775, 1977} - see the compound of CA Registry No. 62921-40-8;

ac) Taniguchi et al. {U.S. Pat. 6,025,375} - see the compound in column 25, line 55;

ad) Fitzi et al. {GB 1,328,550} -see, for example, the compound on page 12, lines 94-95, etc.;

ae) Suwa et al. {CA 100:185259, 1984} - see, for example, the compound of CA Registry No. 68192-19-8;

af) Lewis et al. {U.S. Pat. 4,659,728} - see, for example, the compound of column 4, line 9;

ag) Jeffreys {CA 47:11053e-f, 1953} - see the compound of CA Registry No. 855404-92-1; or

ah) Sallmann {U.S. Pat. 4,447,431} - see the compound in column 32, line 57.

Each of the above cited prior art disclose at least one compound that is embraced by the instant claimed invention. Therefore, each of the cited prior art anticipate the instant claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-6, 8, 12-15 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Norman et al. {U.S. Pat. 5,719,163}, Talley et al. {WO 96/36617}, Barreau et al. {U.S. Pat. 5,403,852}, Dahm et al. {U.S. Pat. 4,051,250}, Derible et al. {FR 2,156,486}, Brown {U.S. Pat. 3,578,671} and Brown {GB 1,206,403}.

Determination of the scope and content of the prior art (MPEP §2141.01)

Applicants claim oxazole compounds. Norman et al. (column 3, lines 1-35; column 57 and column 58; and especially the compound in column 6, lines 5-6 and the compound in column 60, lines 50-51), Talley et al.

(pages 4-6 and 220-224; and especially the compound on page 21, lines 27-28), Barreau et al. (column 1, lines 6-29; columns 20-21; and especially the compound in column 6, lines 61-62), Dahm et al. (column 1, lines 12-37; column 17; and especially Example 32 in column 57, lines 28-30), Derible et al. (page 1, page 3; and especially Compound 1285-04 in Table 1 on page 4), Brown '671 (column 1, lines 18-59, column 3, lines 16-37; and especially Example 2 in column 3) and Brown '403 (page 1, column 2, page 2, column 1; and especially Example 2 on page 4) each teach oxazole compounds that are either structurally the same as (see above 102 rejections) or structurally similar to the instant claimed compounds.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between some of the compounds of the prior art and the compounds instantly claimed is that the instant claimed compounds are generically described by the prior art.

Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)

The indiscriminate selection of "some" among "many" is *prima facie* obvious, *In re Lemin*, 141 USPQ 814 (1964). The motivation to make the claimed compounds derives from the expectation that structurally similar compounds would possess similar activity (e.g., an anti-inflammatory).

One skilled in the art would thus be motivated to prepare products embraced by the prior art to arrive at the instant claimed products with the expectation of obtaining additional beneficial products which would be useful in treating, for example, inflammation. The instant claimed invention would have been suggested to one skilled in the art and therefore, the instant claimed invention would have been obvious to one skilled in the art.

Allowable Subject Matter

The elected species of Example 41, found on page 58 of the specification, is allowable over the art of record.

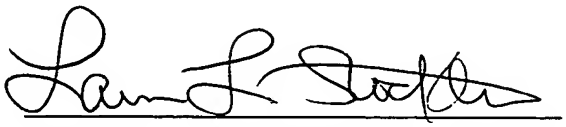
Claim 9 is objected to for containing non-elected subject matter. Claim 9 presented directed solely towards the elected invention of Group I would appear allowable over the art of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (571) 272-0710. The examiner can normally be reached on Monday-Friday from 6:15 am to 2:45 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (571) 272-0699.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact

the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The Official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.



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